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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/702,041	11/06/2003	Anthony Fred Mercurio	66307-291-7	7411
25269	7590	04/06/2007	EXAMINER	
DYKEMA GOSSETT PLLC FRANKLIN SQUARE, THIRD FLOOR WEST 1300 I STREET, NW WASHINGTON, DC 20005			METZMAIER, DANIEL S	
ART UNIT		PAPER NUMBER		1712
SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE		
3 MONTHS	04/06/2007	PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/702,041	MERCURIO ET AL.
	Examiner Daniel S. Metzmaier	Art Unit 1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 15 September 2006.  
 2a) This action is **FINAL**.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 10-16 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) 10 and 11 is/are allowed.  
 6) Claim(s) 12-16 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____	5) <input type="checkbox"/> Notice of Informal Patent Application
	6) <input type="checkbox"/> Other: _____

## DETAILED ACTION

Claims 10-16 are pending.

### *Claim interpretation*

1. The following interpretation is presented for the remaining issues in this Official Office Action. The claims are directed to an aerosol composition prepared from a biliquid foam, an aqueous phase and a propellant. The instant case is a continuation-in-part of the application of application serial number 10/288,590. The instant application includes the following subject matter not set forth in 10/288,590:

Page 1, last ¶;  
Page 2, 1<sup>st</sup> ¶;  
Page 7, line 13, to page 9, line 13;  
Examples 11-14, page 14, line 31, to page 16, line 27.

The scope of the instant claims 12-16 include subject matter with an effective date of the instant filing date of November 6, 2003 including instant examples 11, 13 and 14 employing carbomer.

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 15 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicants rely on page 8, lines 20-25 and the

recitation of Harry's Cosmeticology, 7<sup>th</sup> ed., but said reference was not incorporated by reference. Therefore, the incorporation of materials not explicitly provided for in the original specification is deemed to be new matter.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 12-14 and 16 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Moodycliffe et al, US 6,881,757, optionally in view of Barlow, US 5,849,838. Moodycliffe et al (examples and claims) disclose aerosols reading on the claimed compositions. Moodycliffe et al '757 (column 2, lines 31 et seq) discloses the propellant gas is a hydrocarbon gas. Petroleum gas (instant claim 3) is a hydrocarbon gas. Moodycliffe et al '757 (column 4, lines 10 et seq; column 5, line 1 et seq, lines 25 et seq ; and claims) discloses compositions that employ biliquid foam comprising oil soluble materials if about 18, 16 and 0.1 % by weight making up the majority of the biliquid foam, 10 % by weight propellant and the balance water. Said concentrations read on those in instant claim 5. Moodycliffe et al '757 (column 3, line 59 et seq) discloses cationic surfactants and Moodycliffe et al '757 (column 6, lines 22-26) disclose the aerosols form products of surface and air treating compositions including polishes, cleaners, and fragrancers. Moodycliffe et al '757 (column 4, lines 38-64) discloses making the aerosols in a pressurized container.

Moodycliffe (column 3, line 24) discloses the use of fragrances. Said term is deemed synonymous with perfume. Moodycliffe (claims) further discloses air-treating materials, which would have been expected to contain perfumes as provided for in the Moodycliffe disclosure.

Moodycliffe (column 4, line 28; and column 5, 55-58) discloses Kathon®, which includes methylchloroisothiazolinone and methylisothiazolinone and are repellants as claimed.

Claim 16 reads on the insect repellant of column 5, lines 1 et seq; and the follicle softener would have been inherent since the remaining composition is anticipated. The characterization as a follicle softener has been treated as a recitation of intended use in the preamble.

To the extent Moodycliffe et al lacks a disclosure of wax, Moodycliffe cites Barlow at column 3, lines 23-26, as teaching art known polish ingredient including wax at column 1, line 11.

***Allowable Subject Matter***

8. Claims 10-11 and claim are allowed.

***Response to Arguments***

9. Applicant's arguments filed April 14, 2006 have been fully considered but they are not persuasive.

10. Applicant's arguments with respect to claims 12-16 have been considered but are moot in view of the new ground(s) of rejection. Upon reconsideration of the case as a whole, the following remarks are noted.

11. Applicants' declaration under 37 CFR 1.131 has not been deemed to be adequate to antedate the Moodycliffe et al reference for the following reasons.

The evidence presented does not clearly correspond with the declarants' statements. In particular, the evidence contains numerous hand written portions that

are illegible. As such, the legible portions are therefore relied. Said legible portions do not support applicants' conclusions. Only 100-179 to the air freshener clearly shows a propellant as required by all the claims but it is unclear that said composition is in biliquid foam form. Of the remaining evidence, 100-211 and 100-245, contain isopentane, which would not be considered a aerosol propellant by possibly a post-foaming agent.

For the above reasons, the declaration evidence has not been deemed probative.

***Conclusion***

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel S. Metzmaier whose telephone number is (571) 272-1089. The examiner can normally be reached on 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy P. Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



**Daniel S. Metzmaier**  
Primary Examiner  
Art Unit 1712

DSM